

Attorney's Docket: 2001US405
Serial No.: 10/002,710
Group: 1615

REMARKS

The Office Action mailed August 12, 2003, has been carefully considered together with each of the references cited therein. The amendments and remarks presented herein are believed to be fully responsive to the Office Action. The amendments made herein are fully supported by the Application as originally filed. No new matter has been added. Accordingly, reconsideration of the present Application in view of the above amendments and following remarks is respectfully requested.

CLAIM STATUS

Claims 1-19 are pending in this Application. By this Amendment, claims 1, 11-13, 15, 16 and 19 have been amended, while claim 10 has been cancelled. The claims under consideration therefore include claims 1-9 and 11-19.

Claim Rejections Under 35 USC § 102

Claims 1-9, 18 and 19 stand rejected under 35 USC § 102(b) as being anticipated by LeGrow et al. (US 5,932,231). This rejection has been overcome.

Independent claim 1 has been amended to recite that the leave-on composition is an emulsion. As LeGrow does not disclose, teach, or suggest an emulsion, it is Applicants' position that independent claim 1, and all claims depending therefrom, is not anticipated by LeGrow.

Claim Rejections under 35 USC § 103

Claims 10-17 stand rejected under 35 USC § 103(a) as being unpatentable over LeGrow et al. (US 5,932,231) in view of Collin et al. (US 5,643,555).

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The Office is of the position that LeGrow teaches the composition but fails to teach an emulsion. The Office states that "Collin discloses an emulsion composition that comprises polyalkylsilsesquioxane and that Collin's composition has a pleasant texture, powdery and soft feel and cool effect." The Office concludes that "one having ordinary skill would have been motivated to prepare the formulation of LeGrow as an emulsion according to the teaching of Collin with the expectation that the alkylsilsesquioxane/polyalkylsilsequioxane emulsion composition will provide pleasant texture, powdery and soft feel and cool effect when applied to the skin or hair".

With respect to claims 12 and 13, which now depend from independent claim 1, independent claim 1 in conjunction with claims 12 and 13 will be addressed.

It is Applicants' courteous position that one with ordinary skill in the art would not have the motivation to make the combination proffered by the Office, and, in consequence, the Office has failed to put forward a *prima facie* case of obviousness.

It is admitted by the Office in paragraph 5 of the Office Action that "LeGrow fails to teach an emulsion". Furthermore, as stated by the Office in the Examiner's statement of reason for allowance in the Notice of Allowability filed before the present RCE:

Collin et al. (US 5,643,555) discloses emulsion that contains polyalkylsilsequioxane particles (an abstract in claim 1) and in the cream formulations of examples 1 and 2 specifically uses polymethylsilsesquioxane. The polymethylsilsesquioxane in Collin is different from the trimethylsilylalkyl-silsequioxane of the application in that the sesquioxane of the application further contains a second alkyl group.

Thus, the chemical compounds of LeGrow and Collin are independent and distinct. As a result, in order for one with ordinary skill in the art to

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contemplate the modification as proposed by the Office, the ordinary artisan would have to conclude that the compound advanced in LeGrow could be advantageously employed in the emulsion advanced by Collin. Simply put, there is nothing in the prior art which would provide the ordinary artisan with the knowledge that the compound advanced by LeGrow could be employed in the emulsion advanced by Collin to yield advantageous results. Without this knowledge, the ordinary artisan would have no motivation to alter the Legrow reference in a manner which would arrive at Applicants' invention.

Beyond having no motivation for one with ordinary skill in art to make the combination proposed by the Office, the Office's *prima facie* case is also wanting because there exists no reasonable expectation of success that the resultant combination would provide any functional or sensory benefit. This is so because, as advanced by the Office, the silsesquioxane of Collin et al. and LeGrow are distinct and different. There is, therefore, no reason to expect that one with ordinary skill in the art would have any reasonable expectation that the chemical compound advanced by LeGrow would be advantageously employed in the emulsion of Collin, without necessarily employing hindsight gained by a knowledge of Applicants' disclosure.

In view of the forgoing, it is respectfully contended that claims 11-13 are not made obvious by any combination of LeGrow in view of Collin.

With respect to independent claim 14, Applicants claim a process for increasing the gloss and sheen of hair which comprises applying an effective amount of a leave-on composition according to formula (1).

Both the Collin and LeGrow disclosure are directed to cosmetic compositions. There is nothing in either LeGrow or Collin which would suggest to one with ordinary skill in the art that the process using a trimethylsilylalkylsilsesquioxane of the formula (1) would have any beneficial effect on the gloss and sheen of hair. Simply put, the prior art is silent with

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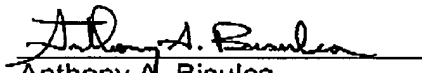
respect to the use of trimethylsilylalkylsilsesquioxanes in hair. Claim 14 is therefore not made obvious by any combination of Legrow and Collin.

With respect to amended independent claims 15 and 16, and all claims depending therefrom, the claims are directed to processes for increasing the emolliency and water repellency of skin, both of which employ a leave-on composition, wherein the leave-on composition is an emulsion. For at least the reasons advanced with respect to the § 103 rejection of claims 11-13, it is Applicants' position that independent claims 15 and 16, and all claims depending therefrom, are not made obvious by any combination of LeGrow in view of Collin.

In view of the foregoing, Applicants courteously solicit reconsideration and withdrawal of the § 103 rejection.

In view of the forgoing amendments and remarks, the Application is believed to be in condition for allowance, and reconsideration of it is requested. If the Examiner disagrees, she is requested to contact the attorney for Applicants at the telephone number provided below.

Respectfully submitted,


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